

REMARKS*Request to Withdraw Finality of Office Action*

The Office Action dated November 26, 2002 was made final due to the amendment filed on September 13, 2002. The Office Action further stated that “previous
5 rejection has been withdrawn and the following reflects the claims as amended”.

Reconsideration of finality of the Office action is respectfully requested.

MPEP § 706.07(a) states:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is
10 neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). ... Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes
15 a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

20 It is respectfully submitted that the withdrawal of the previous rejection was not due to the amendment at least because independent claim 23 was not amended.

Additionally, the introduction of the new ground of rejection was not based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), because no such
25 information disclosure statement was filed. Moreover, any claim (e.g., claim 23) not amended by applicant or patent owner, in spite of the fact that other claims may have been amended to substantiate the new ground of rejection, cannot be used to make a rejection final (*see*, MPEP § 706.07(a), *supra.*).

Accordingly, it is requested that the finality of the Office Action be withdrawn.

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Regarding Declaration of Prior Invention to Overcome Cited Patent

In accordance with 37 C.F.R. 1.131, when any claim of an application is rejected under 35 U.S.C. § 102(e) or 35 U.S.C. § 103(a) based on a U.S. patent to another and which substantially shows or describes but does not claim the same patentable invention,

the inventor of the subject matter of the rejected claim may submit an appropriate declaration to overcome the cited patent.

Although the cited patent, as discussed herein, individually or in combination, do not show or describe the same patentable invention, the inventors of the subject matter of the rejected claims hereby respectfully declare under 37 C.F.R. 1.131 that the present invention was conceived and reduced to practice prior to the effective filing date of the cited patent. The declaration and exhibits accompanying and forming part of the declaration filed herewith include facts showing a completion of the invention in this country before the filing date of the application on which the cited U.S. patent issued.

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Regarding 35 U.S.C. § 102(e) rejections

Claims 1-9, 11, 18, 22, 23-26, 29, 32, 33-41, 43, and 46 were rejected under 35 U.S.C. § 102(e) as being anticipated by Verba et al. (U.S. Pat. No. 6,236,977, hereinafter "Verba"). The rejections are respectfully traversed and reconsideration is earnestly requested. The traversal is collectively discussed herein with respect to independent claims 1, 23, and 33.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990) (emphasis added).

It is respectfully submitted that Verba fails to anticipate each and every element as set forth in claims 1-9, 11, 18, 22-26, 29, 32-41, 43, and 46, particularly in independent claims 1, 23, and 33. Verba is distinguished from the claimed invention at least because Verba does not teach or suggest, *inter alia*, automatically generating intender leads from prospects without requiring human intervention or interaction, as taught and claimed in the present invention.

The examiner argued that Verba's virtual personal assistant "allows" the automatic generation of intender leads, citing col. 10, lines 28-31, and col. 8, lines 35-40, of Verba [Office action, page 3, para. 4]. The specific cited columns and lines are repeated below:

5 "For example, agents **56** can interact with virtual personal assistants **58** to set up customized self-optimizing campaigns for their listings which automatically allow all prospective buyers to compete in the exchange for a chance to be contacted by that agent's campaign." [col. 8, lines 35-40].

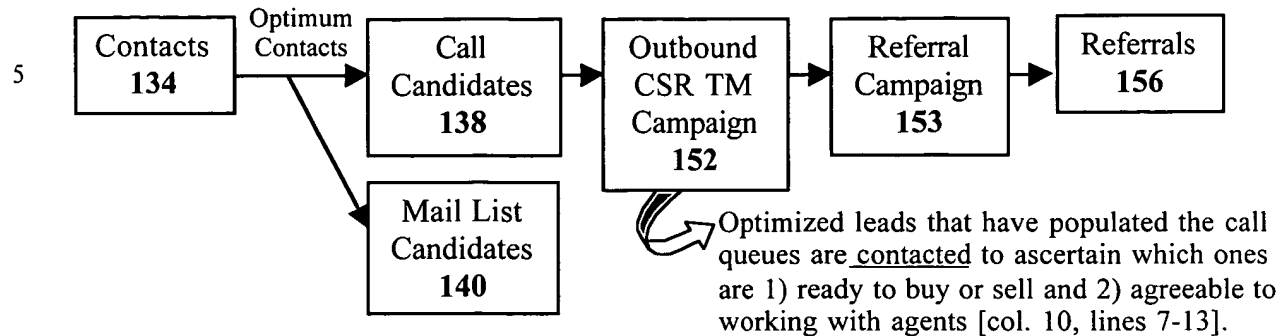
10 "In the preferred implementation, these sales leads would be supplied [to the agents **56**] as qualified referrals through the virtual personal assistant agent **58**." [col. 10, lines 28-35].

It is respectfully submitted that "allowing something to happen" is not the same as "generating that something." Here, the virtual personal assistants **58** assist agents **56** in
15 setting up customized self-optimizing campaigns and in supplying (not generating) qualified referrals to agents **56**. Nothing in Verba teaches or suggests that intender leads can be automatically generated without human intervention and/or interaction. In Verba, human intervention and/or interaction, e.g., actions by prospective buyers, is particularly evident in the cited column 8 where "all prospective buyers ... compete in the exchange
20 for a chance to be contacted."

In other words, assuming the claimed intender leads are analogous to Verba's referral data (it is not readily apparent whether these "referrals" are indeed analogous to "intender leads" -- "qualified prospects that are ready to purchase in the near future", as defined in the specification, page 2, line 2), the "automatic feature" of Verba still fails to
25 automatically generate referral data without requiring human input as the examiner alleged. For example, in cited col. 6, lines 38-40, the virtual personal assistant automatically handles many functions currently handled by human assistants hired by human real estate agents, including calling candidates to ascertain the their propensity to become referrals. This is in sharp contrast to the claimed invention in which it is not necessary to call or
30 otherwise contact the optimum candidates (qualified prospects) in order to generate the intender leads (referral data).

The examiner was partially correct in stating that Verba shows that referral data is generated and processed by software components, citing col. 9, lines 26-28, and lines 50-

54, of Verba [Office action, page 8, para. 9]. However, the examiner was incorrect in stating that the referral data is generated without human intervention. The cited column 9 refers to Fig. 4 of Verba. Below is a simplified version thereof.



In Verba, the aggregated set of contacts **134** is created from all the inbound campaigns including hotline, open house, seminar, direct mail, Internet, and so on [col. 9, lines 29-38]. Notice in every one of these different inbound campaigns, members of the public population (potential or actual buyers or sellers) are aware of the inbound campaigns and most are willing participants. For example, a member of the public population may call a hotline, attend an open house or seminar, respond to a direct mail or survey questions, or even set up his/her own campaign [col. 2, lines 36-43; col. 8, lines 12-45].

The aggregated set of contacts **134** is optimized (scored and analyzed) to determine which of these optimum contacts (optimized leads) would be best handled by mailing list and which would be best handled by direct telephone call [col. 9, lines 42-47]. Based on this determination, the contacts data are routed to the call candidate's component **138** and the mail list candidate's component **140** [col. 9, lines 50-54].

The referral data **156** is generated from the call candidate's component **138** but not without human intervention and/or human interaction. Specifically, outbound call candidates are forwarded to the outbound CSR telemarketing campaign component **152** to administer the desired campaign. Note that while it is true that the outbound CSR telemarketing campaign component **152** can be administered by either a human or virtual customer service representative, the candidates (optimized leads) in both cases must be called/contacted to ascertain which ones are ready to buy or sell a property and agreeable to working with the agents to do so [col. 10, lines 7-13]. Nothing in Verba teaches or

suggests eliminating the outbound CSR telemarketing campaign component 152 so that referral data can be generated without contacting the call candidates.

The following exemplifies how referral data are generated in Verba [Fig. 4]:

5 You went to an auto show in November 2002 and filled out a survey questionnaire -- the inbound campaign 132 from where an aggregated set of contacts 134 is created [col. 9, lines 29-38]. Your answers to the survey questionnaire were scored and analyzed by the telemarketing exchange process 136 [col. 9, lines 42-47]. Since you indicated in the survey questionnaire that you may be interested in buying a new car in 2003, the telemarketing exchange process 136 determines that you would be best handled by a direct telephone call and put you on the call queue of the call candidates 138 [*id.*]. Two weeks later, when you were enjoying the Thanksgiving dinner, the phone rang and it was the outbound CSR telemarketing campaign 152, administered by either a human or virtual customer service representative. You were asked if you were ready to buy a new car and would you agree to work with Agent 164 who could help you to get the best deal around [col. 10, lines 7-13]. Although you were a bit annoyed by the phone call, you said yes to both questions because you just received your production bonus and were in the holiday spirit. With your positive answer, the outbound CSR telemarketing campaign 152 forwarded your data to the referral campaign 153 which in turn stores referrals where they can be extracted, optimized and supplied to Agent 164 [col. 10, lines 14-31].

The following exemplifies how intender data are generated in the claimed invention [see also, Fig. 2]:

25 You placed an ad in the Yahoo! Autos, a publicly accessible web site, to sell your 1984 Porsche. The Yahoo! Autos is one of the sources available to be accessed and searched in the distributed computer system [Claim 1 – determining at least one source available to be accessed and searched in the distributed computer system; Spec. page 7, lines 5-8]. Although you did not indicate in the ad why you are selling the Porsche (because you and your wife decided that it is time to buy a bigger vehicle that will accommodate your growing family – your wife just found out that she's pregnant), studies have shown that classified automobile sales advertisements are a useful leading indicator. [Claim 1 – searching and accessing the source to identify purchase indicators representing potential future purchases, the purchase indicators being contained within files in the source; Spec. page 7, lines 8-25]. Unbeknownst to you, the Yahoo Autos web site (source) was searched and accessed the same day your ad was posted via an automated data mining spider by a company that employs the claimed method and system [Spec. page 8, lines 1-6]. The file that contains your sales ad (purchase indicator) at the source site was identified and information about you was extracted [Claim 1 – extracting prospect identifiers from the purchase indicators; Spec. page 8, lines 18-21]. A predictive model is applied to the extracted information to predict whether you are an intender, i.e., likely to buy a new car, used car or no vehicle in the near future, thereby generating a list of intender leads without calling or otherwise disturbing you [Claim 1 – generating the intender lead without requiring human intervention or interaction; Spec. page 10, lines 14-34, page 14, lines 27-30].

As the above example shows, in the present invention, the intender leads (referral data) are automatically generated transparent to the public population, i.e., no human intervention/interaction is necessary in generating the intender leads. In fact, the present invention does not involve inbound campaigns that require actions from the public population to identify themselves as prospects, nor does it require any outbound campaigns including the outbound CSR telemarketing component to generate the referral data. Qualified prospects (call candidates) are not contacted unless they are identified as intenders (referrals) [Fig. 2].

Since human intervention as well as interaction is required in Verba in generating the referral data, Verba does not anticipate each and every element as set forth in the claims. Verba is additionally distinguished because of the following:

1) Verba does not teach data mining.

The examiner argued that Verba teaches data mining because the data in Verba is also extracted through inbound campaigns. It is respectfully noted that “inbound campaigns” is not analogous to “data mining”. As is known in the art at the time of invention, data mining is an information extraction activity whose goal is to discover hidden facts contained in databases. Using a combination of machine learning, statistical analysis, modeling techniques and database technology, data mining finds patterns and subtle relationships in data and infers rules that allow the prediction of future results.

That is, unbeknownst to the public population, the present invention relies on powerful, automated data mining techniques to access through a variety of file formats as well as data layouts and search the vast information sources available on the Internet to efficiently and effectively identify prospects without the inbound campaigns [Spec. page 11, line 25, through page 12, line 4].

On the other hand, in Verba, the public population proactively provides or otherwise supplies data to the inbound campaigns. By their actions of calling in or responding to the inbound campaigns, participants are positively identified as “contact leads” (prospects). There are no hidden facts to be discovered. Note in Verba, the Internet is used as a medium where an inbound campaign can be administered. The vast amount of databases (sources) on the Internet is not searched or mined.

2) Verba does not teach Purchase Indicators.

The examiner argued that Verba's home buying and selling readiness state of the aggregated set of contacts derived from the campaign is analogous to purchase indicators contained within files in Internet sources. It is not. In Verba, predicted scores for home buying and selling readiness state are generated to complement scores calculated via the scoring process [col. 9, lines 32-42]. In all cases, scores are derived from user supplied rules for interpreting survey questions or market behaviors via inbound campaigns [col. 7, lines 13-16].

Contrastingly, the present invention uses non-traditional means of identifying intenders in an automated way. The purchase indicators of the present invention have nothing to do with user supplied rules or predicted scores generated thereof. In the present invention, purchase indicators are derived from classified ads, resumes, auction boards, life change announcements, or postings to newsgroups, discussion forums, or email lists from publicly accessible web sites without any inbound campaigns [Spec. page 7, lines 5-16; page 14, line 9, through page 17, line 21]. It took a one year pilot test with the industry's leading supplier of auto marketing data (The Polk Company, www.polk.com, see also, Spec. page 9, line 19, through page 10, line 12) to validate that listing an automobile for sale in a classified ad is a leading indicator of an impending auto purchase, as presented in the above example. This validation was the key reason Polk signed a \$1 million four-year data purchase agreement on November 30, 1998 with Sift, Inc., the assignee of the provisional patent application No. 60/116,445, filed 1/19/1999.

3) Verba does not teach front-end Predictive Modeling.

The examiner argued that Verba teaches front-end predictive modeling because Verba also relies on front-end data such as inbound campaigns such as the public calling a hotline. It is respectfully submitted that such reliance on front-end data is not front-end predictive modeling. As the examiner recognized, these callers are treated by the campaign as "potential leads" (contacts 134). As taught in Verba and shown in the above example, these potential leads' propensity to buy is not predicted by a front-end

predictive model], rather, it is ascertained via live phone calls or direct mails (138, 152, 140).

Independent claims 1 and 33 are amended herein to further distinguishing the present invention from Verba and to particularly pointing out and claiming the subject matter which applicants regard as the invention. In particular, claims 1 and 33 recite that the intender leads are generated without requiring human intervention or interaction. Moreover, although not required, claims 1 and 33 further respectively recites that a predictive model is applied to select intender leads from the prospects, as in the preferred embodiment of the present invention. For at least the foregoing reasons, Applicants respectfully submit that the claimed invention is patentably distinct from and not anticipated by Verba. More specifically, independent claims 1, 23, and 33 recite subject matter not reached by applicable prior art under 35 USC § 102(e). As such, it is submitted that independent claims 1, 23, and 33 are patentable and therefore should be allowed.

Reliance is placed on *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) and *Ex parte Kochan*, 131 USPQ 204 (Bd. App. 1960) for allowance of the dependent claims 2-22, 24-32, and 33-46, since they differ in scopes from their respective parent independent claims 1, 23, and 33 which are submitted as patentable.

Regarding 35 U.S.C. § 103(a) rejections:

Dependent claims 10, 27, 42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Verba in view of Cannon (U.S. Pat. No. 6,286,005). Dependent claims 12-16, 19-21, 30, 31, 44, and 45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Verba. Dependent claim 17 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Verba in view of Lazarus et al. (U.S. Pat. No. 6,134,532, hereinafter referred to as "Lazarus"). The rejections are respectfully traversed and reconsideration is earnestly requested.

For similar reasons discussed herein with respect to Verba, it is respectfully submitted that Verba, Cannon, and Lazarus, individually and in combinations, do not teach or suggest the invention as set forth in the claims. Note Cannon teaches parsing

machine-generated Nielsen files that are easily accessible and have a highly structured, though cryptic, format. There is no teaching for accessing, extracting and normalizing semi-structured data, such as online classified ads or discussion forums, in a variety of file formats and layouts from thousands of websites. More importantly, as discussed above
5 with respect to 35 U.S.C. § 102(e) rejections, in the present invention, the intender leads are generated without requiring human intervention or interaction, completely transparent to the public population. The qualified prospects need not proactively participate in or otherwise be aware of the inbound campaigns or answer phone calls.

As a result, the present invention has an unexpected advantage over Verba , as
10 well as all the alleged combinations with Verba, of not having to disturb the entire pool of qualified prospects but only intenders who are ready, able, and willing to buy in the near future. The elimination of the outbound CSR telemarketing campaign component **152**, among others, also means the elimination of cost and expenses related thereto, resulting a much more efficient, productive, and cost effective direct marketing methodology.

15 What is more, “the omission of an element and retention of its function is an indicia of unobviousness.” *In re Edge*, 359 F.2d 896, 149 USPQ 556 (CCPA 1966) (emphasis in original), *see also*, MPEP 2144.04(II)(B). Accordingly, the elimination of the outbound CSR telemarketing campaign component **152** and retention of its function in generating the intender leads is an indicia of unobviousness.

20 For at least the reasons discussed herein, it is respectfully submitted that independent claims 1, 23, and 33 recite subject matter not reached by the applicable prior art under 35 USC § 103(a). Reliance is placed on *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) and *Ex parte Kochan*, 131 USPQ 204 (Bd. App. 1960) for allowance of dependent claims 10, 12-17, 19-21, 27, 31, 42, 44, and 45, since they differ in scopes
25 from their respective parent independent claims 1, 23, and 33 which are submitted as patentable.

Conclusion

This Reply is submitted as proper and complete in that it places the application
30 in condition for allowance. Particularly, the present Reply is submitted as not adding new matters and not requiring further searches. Since the examiner has done a thorough

search in the previous actions in light of the disclosure and claims, no new search would be necessary. Accordingly, Applicants respectfully submit that, by the amendments presented herein, the present application is in a condition for allowance. Favorable consideration and a Notice of Allowance of all the claims are thus earnestly solicited.

- 5 The examiner is invited to telephone the undersigned at (408) 260-7300 extension 23 for discussing an Examiner's Amendment or other suggested actions for accelerating prosecution and moving the present application to allowance.

Respectfully submitted,



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SFT-101/Amt B

MARKED UP VERSION OF THE AMENDED CLAIMS:

1. (Twice Amended) In a distributed computer system, a method of automatically generating [an] intender leads, said method comprising the steps of:
determining at least one source available to be accessed and searched in said distributed computer system;
searching and accessing said source to identify purchase indicators representing potential future purchases by prospects, said purchase indicators being contained within files in said source; [and]
extracting prospect identifiers from said purchase indicators, wherein said prospect identifiers identify said prospects;
applying a predictive model to select intender leads from said prospects; and
generating said intender leads from said prospects in accordance with said predictive model without requiring human intervention or interaction.

2. Cancelled.

33. (Twice Amended) A program storage device accessible by a server machine in a distributed computer system, tangibly embodying a program of instructions executable by said server machine to perform method steps for automatically generating [an] intender leads, said program of instructions comprising:
program code means for searching and accessing at least one source in said distributed computer system;
program code means for identifying purchase indicators representing potential future purchases by prospects, said purchase indicators being contained within files in said source; and
program code means for extracting prospect identifiers from said purchase indicators, wherein said prospect identifiers identify said prospects; and
program code means for predicting and generating said intender leads from said prospects.

34. Cancelled.

such willful false statements may jeopardize the validity of the application or any patent issued thereon.

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Signature: _____

Name: _____

Title: _____

Jeff Wilkins

Jeff Wilkins

CEO & Chairman

1/10/03

Date